REMARKS

Applicants respectfully submit that the claims have been amended to more clearly point out the present invention, and that all the claims presently on file are in condition for allowance.

THE CLAIMS

DOUBLE PATENTING

Claims 1-48 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11, 20, 28, 36 and 44 of copending Application No. 11009272. Applicants respectfully submit that this rejection has now become moot in view of the current amendment to the claims on file.

CLAIM REJECTIONS UNDER 35 USC 101

Claims 33-48 were rejected under 35 U.S.C. 101 on the ground that the claimed invention is directed to non-statutory subject matter. The claims as amended, and in particular claims 33 - 40 are in compliance with 35 USC 101.

REJECTION UNDER 325 USC 102

Claims 9-10, 12-14, 25-26, 28-30, 41-42, and 44-46 were rejected under 35 U.S.C. 102(b) as being anticipated by Pestoni's IMA talk titled "Content Protection for Recordable Media" on Feb 16, 2001, hereinafter referred to as "Pestoni". Applicants traverse this rejection, and respectfully submit that this rejection has now become moot in view of the cancellation of the rejection claims without prejudice.

REJECTION UNDER 325 USC 103

Claims 1-5, 8, 17-21, 24, 33-37, 40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pestoni in view of Akishita (US 20020184259). Applicants respectfully submit that neither reference discloses all the elements and limitations of the claims on file as a whole. Consequently, the claims on file are not obvious under 35 U.S.C. 103, and the allowance of these claims is earnestly solicited.

The allowability of the rejected claims will now be discussed in view of representative claim 1. With respect to claim 1, Applicants agree with the Examiner that: "**Pestoni does not explicitly teach** dividing the multimedia content on the physical media into multiple parts, each part being encrypted with a different encryption key." Emphasis added.

In particular, Applicants submit that Pestoni does not disclose "randomly selecting content keys corresponding to each part of the

multimedia content;" and "encrypting the parts of the multimedia content with corresponding content keys", as recited in claim 1.

As indicated in paragraph [0066] of the present specification, the "content owner 405 randomly picks content keys for each part of the content on the enhanced media 15 at step 510. At step 515, the content owner 405 selects a media key block 205 from the set of media key blocks 430 provided by the licensing agency 410. The content owner 405 encrypts the content keys for the content on the enhanced media 15 using the media key block 205 at step 520."

This novel design of the present invention presents a significant advantage over the conventional methods. As indicated in paragraph [0008] of the present specification, one "approach to protecting copyrighted content on physical storage or memory media is to have the user connect to a web service provided on the Internet to authorize or purchase the content. **A conventional approach for this connection is a public/private key system**. A web service provider and the DVD player each have a public key. The DVD player and the web service provider handshake on a **public/private key** to verify the web service provider and the DVD player. The key would be delivered based on the handshake, establishing a secret key. However, the public key calculation is a complicated calculation and is difficult to perform. Furthermore, the handshake requires an active online connection, which may be inconvenient for the user."

According to the present invention recited in the exemplary claim 1, the handshake on the public/private key is eliminated, ensuring that the relationship between the service provider and the player manufacturer is secure without the complexity of the public/private key.

As a result, Applicants respectfully submit that **Pestoni** does not consider the present invention as a whole.

The Examiner resorts to Akishita as teaching the encryption of multiple sectors of a DVD with multiple content keys (Fig. 27 a-b, "multiple content keys...sewing as encryption keys corresponding to sectors...are encrypted and stored in the security header configured corresponding to the contents" Paragraph [0489])." However, similarly to Pestoni, Akishita does not describe the present invention as a whole.

In support of the combination of Pestoni and Akishita, the Examiner states as follows:

> "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Graunake to divide the physical media into multiple parts and encrypt each part with a different encryption key. Emphasis added.

Applicants are not clear whether the reference to "Graunake" is an intentional typographical error. Applicants will proceed with the analysis with the assumption that the Examiner intended to make reference to Pestoni rather than Graunake. Applicants submit that nowhere does Akishita describe the steps of claim 1, particularly the following steps:

"randomly selecting content keys corresponding to each part of the multimedia content;

encrypting the parts of the multimedia content with corresponding content keys;

selecting a media key block from a set of media key blocks;

encrypting the corresponding content keys with the media key block."

As a result, Akishita does not describe the present invention as a whole. Reference is made to the following legal authority in support of the finding of non-obviousness:

> "**In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is** not whether the differences themselves would have been obvious, but **whether the claimed invention as a whole would have been obvious**. The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700."

Consequently, the hypothetical combination of Pestoni and Akishita does not consider the present invention as a whole, necessitating the finding of non-compliance with the foregoing legal standard.

In addition, Akishita **does not provide any teaching or suggestion** to support modifying the Pestoni design to randomly select the content keys corresponding to each part of the multimedia content, and to encrypt

the parts of the multimedia content with corresponding content keys, as recited in claim 1.

The Examiner provided a general reason for the desirability of the combination of Pestoni and Akishita, in hindsight, without referring to any substantive (or significant) teaching or suggestion in Akishita in support of such combination. More specifically, the reason provided by the Examiner is generic and insufficiently specific. The Examiner's reason, which is reproduced below does not provide any ground for the combination of Pestoni and Akishita, to provide the elements of claim 1:

> "The motivation is to allow different parts of a physical medium to have multiple encryptions, instead of just having one key to encrypt the entire disc."

As a result, The Examiner has not met the prima facie burden of supporting the obviousness rejection under 35 USC 103, and the hypothetical combination of Pestoni and Akishita cannot be used to support a finding of obviousness, as indicated by the legal authorities below:

> "**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." *In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598* (citing *ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)*). **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See *Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983)*, cert. denied, *469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984)*."

> "When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the

references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation** to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Claim 1 is thus not obvious in view of Pestoni and Akishita and the allowance of this claim and the claims dependent thereon, is earnestly solicited. Independent claims 17 and 33 are allowable for containing a similar subject matter to that of claim 1. Therefore, claims 17 and 33 and the claims dependent thereon are also allowable.

CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Date: June 13, 2007

Respectfully submitted,

/Samuel A. Kassatly/

Samuel A. Kassatly Law Office
20690 View Oaks Way
San Jose, CA 95120
Tel: (408) 323-5111
Fax: (408) 521-0111

Samuel A. Kassatly
Attorney for Applicants
Reg. No. 32,247